

THIS DISPOSITION IS NOT
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Mailed:
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Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lawn Tennis Association of Australia Limited

Serial No. 78210957

Jeffrey L. Clark of Wood, Phillips, Katz, Clark and
Mortimer for Lawn Tennis Association of Australia Limited.

Kelly F. Boulton, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Quinn, Hairston, and Grendel, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration¹ on the Principal Register
of the mark depicted below

¹ Serial No. 78210957, filed on February 4, 2003. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).



for goods and services identified in the application as follows: in Class 25:

clothing, namely, t-shirts, singlets, jumpers, vests, shorts, skirts, one piece sports dresses, track suit pants and jackets, casual jackets, casual pants, waterproof jackets and vests, windproof jackets and vests, neckties; footwear namely, socks; headgear namely, caps, bucket hats and visors

and in Class 41:

arranging and conducting fitness programs; training, instructional and teaching services, namely, arranging and conducting classes and seminars in the field of tennis; physical education services; providing facilities for sports and recreational activities; providing sport and recreation information; organizing sporting events and competitions; all relating to tennis.

Applicant has disclaimed the exclusive right to use TENNIS WORKOUT apart from the mark as shown, as to the Class 41 services only.

At issue in this appeal are the Trademark Examining Attorney's requirements that applicant disclaim TENNIS WORKOUT as to the Class 25 goods, and disclaim AUSTRALIAN

OPEN TENNIS WORKOUT (not just TENNIS WORKOUT) as to the Class 41 services.² See Trademark Act Section 6, 15 U.S.C. §1056.

Applicant and the Trademark Examining Attorney filed main appeal briefs.³ Applicant did not file a reply brief and did not request an oral hearing.

We turn first to the Trademark Examining Attorney's requirement for a disclaimer of TENNIS WORKOUT as to the Class 25 clothing goods. The basis for the disclaimer requirement is that TENNIS WORKOUT is merely descriptive of the goods. See Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

A mark is considered to be merely descriptive of the goods or services if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It is not necessary

² The Trademark Examining Attorney's pre-appeal final requirement as to the Class 25 goods was that applicant disclaim AUSTRALIAN OPEN TENNIS WORKOUT. In her appeal brief, however, she withdrew her requirement for a disclaimer of AUSTRALIAN OPEN as to the Class 25 goods. Thus, the requirement at issue on appeal as to the Class 25 goods is whether applicant must disclaim TENNIS WORKOUT. The requirement for a disclaimer of AUSTRALIAN OPEN TENNIS WORKOUT as to the Class 41 services has been maintained.

³ We sustain the Trademark Examining Attorney's objection to the third-party registrations cited by applicant in its appeal brief. These registrations were not made of record prior to appeal, and thus will not be considered. See Trademark Rule 2.142(d).

that a term describe all of the purposes, functions, characteristics or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004); *In re Gyulay, supra*. Moreover, it is well-settled that the term in question need not be merely descriptive of each and every item appearing in the applicant's identification of goods; registration must be refused if the mark is descriptive of any of the goods or services identified in the application. See *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 10 USPQ2d 1879 (Fed. Cir. 1989); *In re Canron, Inc.*, 219 USPQ 820, 821 (TTAB 1983); *Electro-Coatings, Inc. v. Precision National Corporation*, 204 USPQ 410 (TTAB 1979); and *In re Brain Research Foundation*, 171 USPQ 825 (TTAB 1971).

The Trademark Examining Attorney has submitted an online dictionary definition of "workout" which defines the term as "a session of exercise or practice to improve fitness, as for athletic competition." American Heritage Dictionary of the English Language (4th ed. 2000). She also has submitted NEXIS evidence showing that there is a type of clothing called "workout clothing" for use during workouts. See, e.g.:

The sleek and somehow smug look of Lycra workout clothing may be on the wane, giving way to the grittier sensibility of gym clothes with a deconstructionist edge. Cotton jackets and track pants by Bella Dahl have pieced racing stripes and raw hems and come...
(The New York Times, Aug. 1, 2004));

...perfect lifting form. "She took the pictures and printed them out," Thwing says. "On each sheet we had two exercises" demonstrated by real women who weren't intimidatingly buff or dressed in expensive workout clothing.
Arkansas Democrat-Gazette (May 24, 2004));

...Stores, Inc. (NYSE: JAS) said Mike Edwards, its executive vice president of operations, will leave the company at the end of May to join Lucy, a Portland, Ore.-based retailer of women's workout clothing.
(Crain's Cleveland Business (May 17, 2004));

Lunch is not included for camps that are day-long. Campers must provide appropriate workout clothing and equipment, such as bats for the hitting camp, and gloves and athletic cup supporters. Each camp is limited to 200 participants.
(The Honolulu Advertiser (May 16, 2004));

Yoga buffs should not miss Lululemon, a mecca of high-quality workout clothing designed specifically for the downward-dog set. (The store's live-a-good-life mottos, prominently displayed, aren't just marketing ploys.
(Rochester Democrat and Chronicle (May 3, 2004)).

The Trademark Examining Attorney also submitted NEXIS evidence which shows that there is a type of fitness or exercise activity called a "tennis workout." See, e.g.:

"We might go to a movie. We might do a little tennis workout at Tower Grove," Kovar said... (St. Louis Post-Dispatch (June 28, 2004));

During his senior year, Shulman began his days with individual tennis workouts before going to class. Then he scurried to high school basketball practice before returning for Bucs tennis practice. (Chattanooga Times Free Press (May 5, 2004));

For the last five years, Gruppo has spent mornings at the small school before tennis workouts, which last from 1:30 to 6 p.m. (Sarasota Herald-Tribune (Jan. 4, 2004));

The singer has also been seen around town on local courts, engaging in his usual early morning routine of a vigorous tennis workout. (The Atlanta Journal-Constitution (Sept. 23, 2003));

Another aspect she focuses more on these days is conditioning. Connor usually puts in a daily running session to go along with her tennis workout. (Tulsa World (April 11, 2003));

He participates in practices with each team every day, staying after with Ellis if he misses a portion of the regularly scheduled tennis workout. (The Indianapolis Star (Aug. 8, 2002));

It was a tennis workout with which Pete Sampras might identify. From his starting position along the baseline, Jacob Johnson raced as hard as he could to a pivot point on the right side of the net. Turning quickly while his coach called out ... (Topeka Capital-Journal (July 12, 2002));

In his first five summers here, Pilsbury devoted all of his time to his young students, teaching individual and group lessons at Watt Powell Annex and supervising all-day sessions of informal tennis workouts. The kids would

bring their lunches to the court and spend the day.

(Charleston Gazette (June 4, 2001));

He had spent much of his spring break in Marietta, Ga., playing in a national tennis tournament and had just come from a two-hour tennis workout.

(News and Observer (Raleigh, NC) (April 18, 2001)).

Based on this evidence, we find that TENNIS WORKOUT is merely descriptive of applicant's Class 25 goods because many, indeed most, of the identified items are types of "workout" clothing which are used or could be used for or during a "tennis workout." TENNIS WORKOUT merely describes a purpose or use of the goods, and it therefore is merely descriptive of the goods.⁴ See *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 184)(WALLYBALL merely descriptive of sports clothing); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977)(BURGER merely descriptive of cooking utensils). We therefore affirm the Trademark Examining Attorney's requirement for a disclaimer of TENNIS WORKOUT as to the Class 25 goods identified in the application.

We also affirm the Trademark Examining Attorney's requirement for a disclaimer of AUSTRALIAN OPEN TENNIS

⁴ Contrary to applicant's argument, it does not matter that some of the identified goods, such as "neckties," usually would not be worn during a tennis workout. As noted above, registration must be refused on the ground of mere descriptiveness if the term in question is merely descriptive of any of the goods identified in the application.

WORKOUT (not just TENNIS WORKOUT) as to the Class 41 services recited in the application. The Trademark Examining Attorney has submitted an online dictionary definition which defines "Australian" as "of or relating to Australia or its peoples, languages, or cultures." American Heritage Dictionary of the English Language (4th ed. 2000). The same dictionary defines "open," in relevant part, as "a tournament or contest in which both professional and amateur players may participate."⁵

Based on this dictionary evidence, we find that AUSTRALIAN OPEN is merely descriptive of applicant's Class 41 services, especially those recited as "organizing sporting events and competitions ... relating to tennis." Applicant organizes and conducts an "open" tennis tournament which takes place in Australia, i.e., an Australian open tennis tournament. AUSTRALIAN OPEN directly and immediately describes this aspect of applicant's services.

⁵ Contrary to applicant's argument, the fact that the term "open" may have meanings other than the one relevant to applicant's goods or services is not controlling, because descriptiveness must be determined in relation to the goods or services for which registration is sought. See *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); and *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974).

Applicant argues that the Australian Open tennis tournament is a famous tournament, one of the four Grand Slam tennis tournaments held every year. According to applicant, AUSTRALIAN OPEN is applicant's "famous" mark, which applicant uses to identify this tournament. Even assuming that this is true, it would be relevant only if applicant were claiming that its otherwise merely descriptive mark has acquired distinctiveness and thus is registerable under Trademark Act Section 2(f), 15 U.S.C. §1052(f). Applicant has not asserted a claim under Section 2(f), and the question of whether AUSTRALIAN OPEN has acquired distinctiveness therefore is not before us.

We note that the Trademark Examining Attorney, in her first Office action, required applicant to submit information establishing its connection to the Australian Open tennis tournament. The purpose of this requirement, presumably, was to determine whether a "false suggestion of a connection" refusal under Trademark Act Section 2(a) should be made, in the event that there were no such connection between applicant and the Australian Open tennis tournament. Applicant argues that the Trademark Examining Attorney's requirement for such information was an implicit acknowledgement that purchasers are familiar with the Australian Open tennis tournament and an implicit

acknowledgement that AUSTRALIAN OPEN is recognized by the public as an indication of the source of that tournament. According to applicant, the Trademark Examining Attorney's acknowledgement that the public would perceive AUSTRALIAN OPEN as a source indicator for applicant's tournament is "incongruous" with the Trademark Examining Attorney's requirement that applicant disclaim AUSTRALIAN OPEN.

We are not persuaded by this argument. At most, the Trademark Examining Attorney's implicit acknowledgement that AUSTRALIAN OPEN functions as an indication of source is some evidence that AUSTRALIAN OPEN has acquired distinctiveness as a service mark. Again, however, the issue of acquired distinctiveness is not before us because applicant has not asserted a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. The issue before us is whether AUSTRALIAN OPEN is merely descriptive of applicant's services, not whether it also has acquired distinctiveness. Applicant's services recited as "organizing sporting events and competitions ... related to tennis" include organizing and conducting an "open" tennis tournament held in Australia. We find that AUSTRALIAN OPEN is merely descriptive of such services, for

the reasons discussed above.

Decision: The requirement for a disclaimer of TENNIS WORKOUT as to the Class 25 goods is **affirmed**. The requirement for a disclaimer of AUSTRALIAN OPEN TENNIS WORKOUT as to the Class 41 services is **affirmed**. Absent submission and entry of such disclaimers, applicant's mark is not registerable.

This decision shall be set aside if applicant, within thirty days from the date of this order, submits the required disclaimers to the Board. Otherwise, the decision affirming the refusal to register shall stand.